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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JALALUDEEN CA and NANDAUMAR GN

Appeal 2008-2923
Application 09/876,568¹
Technology Center 2100

Decided:² March 17, 2009

Before HOWARD B. BLANKENSHIP, JEAN R. HOMERE, and
JAY P. LUCAS, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Filed on June 7, 2001. The real party in interest is Agere Systems Inc.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 32. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Appellants' Invention

Appellants invented a method and system for detecting the removal of a portable computer connected to a network. (Spec. 1.) As shown in Figure 1, the portable computer (110) is equipped with a theft protection utility process to monitor the connection with the network (100). Upon detecting that a user who is not featured in the authorized database (200) has disconnected the portable computer (110) from the network (100), the theft protection utility process (300) generates an alarm to alert other users of an imminent removal of the computer. (*Id.* at 2-3.) The portable computer system also includes a fail-safe mechanism to prevent the computer from being turned off or to prevent the volume of the computer from being reduced below a predetermined threshold minimum. (*Id.* at 4-5.)

Illustrative Claim

Independent claim 1 further illustrates the invention. It reads as follows:

1. A method for detecting removal of a device connected to a network by a network connection, comprising:

monitoring said network connection; and
generating an alarm in said removed device if said network
connection is disconnected.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of
unpatentability:

| | | |
|---------|--------------|---------------|
| Sanders | 5,231,375 | Jul. 27, 1993 |
| Cromer | 6,021,493 | Feb. 1, 2000 |
| Lam | 6,140,923 | Oct. 31, 2000 |
| Pearce | 6,308,272 B1 | Oct. 23, 2001 |

Mark Minasi, *Mastering Windows NT Server 4*, at 378, 380, 434
(Sybex Inc., 6th ed. 1999) (hereinafter “Minasi”).

Charles J. Sippl and Roger J. Sippl, *Computer Dictionary and
Handbook*, at 12 (H.W. Sams, 3rd ed. 1980) (hereinafter “Computer
Dictionary”).

Mark G. Sobell, *A Practical Guide to the UNIX System*, at 493
(Addison Wesley, 3rd. ed. 1994) (hereinafter “Sobell”).

Paul Thurrott, *What's new in Windows 2000 RC2 Reviewed*, at 1-3,
http://www.winsupersite.com/reviews/win2k_rc2_whatsnew.asp (hereinafter
“Thurrott”).

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

1. Claims 1, 10, 17, 22, 26 through 29, 31, and 32 stand rejected
under 35 U.S.C. § 102(b) as being anticipated by Thurrott.

2. Claims 1, 7 through 10, 12, 17, 22, 26 through 29, 31, and 32 stand rejected under 35 U.S.C. § 102(b)/103(a) as being anticipated by or, in the alternative, as being unpatentable over Cromer.

3. Claims 2, 3, 13, 14, 18, 19, 23, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Cromer, Sanders, and Lam.

4. Claims 3, 14, 19, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Cromer and Minasi.

5. Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Cromer and Pearce.

6. Claims 6, 11, 15, 16, 20, 21, 25, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Cromer and Sobell.

Appellants' Contentions

1. Appellants argue that Thurrott does not teach generating a theft alarm to indicate the removal of a device from a network. Particularly, Appellants argue that while Thurrott teaches using a visual clue to alert a user of a computer that the computer is disconnected from a network, such an alert is ineffective to prevent an unauthorized user from stealing the computer since it does not alert other people besides the computer user. Therefore, Appellants submit that Thurrott does not anticipate independent claim 1. (App. Br. 4, Reply Br. 4-5.)

2. Appellants argue that Cromer does not teach generating an alarm in the removed device. Particularly, Appellants argue that while Cromer teaches a main computer that sends a theft alert message to a network administrator to indicate that a client computer is being disconnected from the network, the alert message is not generated from a device being disconnected or removed from the network as recited in claim 1. Rather, the alert message is generated from another computer besides the one being disconnected. (App. Br. 5.) Further, Appellants argue that the generated message sent to the administrator is not an alarm, but rather a signal to generate an alarm. (Reply Br. 6.) Additionally, Appellants argue that Cromer does not teach removing the computer system from the network since it is not clear that the computer system would continue to operate to generate an alert message if it is no longer powered by the AC source when it is removed from the network. (*Id.* at 5.) Therefore, Appellants submit that Cromer neither anticipates nor renders independent claim 1 unpatentable. (*Id.* at 6.)

Examiner's Findings/Conclusions

1. The Examiner finds that Thurrott's disclosure of generating a visual cue in a computer to indicate that the computer is disconnected from a network teaches the step of generating an alarm in a removed device when it is disconnected from a network, as recited in claim 1. (Ans. 9-10.)

Consequently, the Examiner finds that Thurrott anticipates independent claim 1. (*Id.*)

2. The Examiner finds that Cromer's disclosure of a server computer, upon determining that a client computer is no longer connected to the network, alerts the network administrator teaches or suggests the step of generating an alarm in a removed device when it is disconnected from the network, as recited in claim 1. (Ans. 10-15.) Consequently, the Examiner finds that Cromer anticipates or renders independent claim 1 unpatentable. (*Id.*)

II. ISSUE

1. Have Appellants shown that the Examiner erred in finding that Thurrott's disclosure anticipates the claimed invention? Particularly, the issue turns on whether Thurrott's disclosure of generating a visual cue in a computer when the computer is disconnected from the network teaches the step of generating an alarm in a removed device when it is disconnected from the network, as recited in claim 1.

2. Have Appellants shown that the Examiner erred in finding that Cromer's disclosure anticipates or renders the claimed invention unpatentable? Particularly, the issue turns on whether Cromer's disclosure of a server that alerts a network administrator upon determining that a computer is disconnected from the network teaches the step of generating an

alarm in a removed device when it is disconnected from the network, as recited in claim 1.

III. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Thurrott

1. As depicted in figure 3, Thurrott discloses a network disconnect cue feature in a Windows 2000 Release Candidate 2 (RC2) that, upon determining a user's machine has been disconnected from the network, displays a visual cue on the user's machine to alert the user that the Ethernet card or the network cable has been disconnected. (P. 1.)

Cromer

2. As shown in Figure 1, Cromer discloses a system for determining when a computer is removed from a network. Particularly, Cromer discloses a server computer (34) having an application software running thereon that periodically sends data packets to client computers (10) connected to a network to determine if these connections are still active. If a polled client fails to respond to numerous status inquiries, the server suspects that the client may no longer be connected to the network, and consequently alerts the network administrator of the client computer being

possibly missing or stolen from the network. (Col. 7, ll. 31-49, col. 9, ll. 21-23.)

Sanders

3. As depicted in Figure 2, Sanders discloses a theft detection and alarm system (1010) that produces an audible alarm signal upon detecting a sustained absence of current in a circuit, indicating that a cable has been disconnected, severed or power has been turned off in a portable electronic device. (Col. 5, ll. 33-43.)

Lam

4. Lam discloses sounding an audible alarm when a retractable cable attached to a portable electronic device is pulled to thereby notify people in the vicinity that trouble is afoot. (Col. 2, ll. 25-30.)

Minasi

5. Minasi discloses a system for creating and managing user rights. Particularly, Minasi discloses that an administrator can assign rights to a user to access certain objects on a server, including the right to shut down the server. (PP. 378, 380.)

IV. PRINCIPLES OF LAW

Claim Construction

"[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (internal citations omitted). "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d at 1323.

Anticipation

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d

1559, 1565 (Fed. Cir. 1992)). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.” (Internal citations omitted)).

V. ANALYSIS

1. *Thurrott- Claims 1, 10, 17, 22, 26 through 29, 31, and 32*

Independent claim 1 recites in relevant part generating an alarm in a removed device if a network connection for the device is disconnected.

We first consider the scope and meaning of the term “alarm,” which must be given its broadest reasonable interpretation consistently with Appellant’s disclosure, as explained in *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997):

[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

See also In re Zletz, 893 F.2d at 321 (stating that “claims must be interpreted as broadly as their terms reasonably allow.”).

Our reviewing court further states, “the ‘ordinary meaning’ of a claim term is its meaning to the ordinary artisan after reading the entire patent.” *Phillips v. AWH Corp.*, 415 F.3d at 1321.

Upon reviewing Appellants’ Specification, we fail to find a definition for the claim term “alarm”. We therefore construe alarm consistently with its ordinary meaning as provided in a dictionary.

The Examiner construed “alarm” as a visual signal that alerts a computer user that the computer is disconnected from the network. As support for construing the term “alarm” in the stated manner, the Examiner asserts that

Computer Dictionary defines the term “alarm” as a “signal, by display or audio device, which signifies that an error has occurred, or an emergency condition exists that is interfering or could interfere with the proper execution or completion of a program”.

(Ans. 9.)

Alternatively, Appellants recur to *Dictionary.com* to provide a narrower definition of “alarm” as

an “automatic device that serves to call attention, to rouse from sleep, or to warn of fire, smoke, an intruder, etc.”

(Reply Br. 4-5.)

We will apply the broader definition offered by the Examiner since it gives the term alarm its broadest reasonable interpretation. As set forth in the Findings of Facts section, Thurrott discloses that upon determining that

the user's computer is disconnected from a network, displaying a visual cue on the user's computer to alert the user of the disconnection. (FF. 1.)

Consistently with the broader definition of alarm adopted above, we find that by displaying the visual cue on the user's own computer, Thurrott teaches that an alarm is generated in the user's computer to alert the user that his/her computer has been disconnected from the network. Further, we agree with the Examiner that Thurrott's teaching that the user computer has been disconnected from the network also implies that the computer has also been removed therefrom since it is no longer part of the network.

Additionally, we agree with the Examiner that Appellants' argument regarding Thurrott's alarm not being a theft alarm is not commensurate in scope with the claim because the claim does not recite a *theft* alarm.

Appellants' argument is therefore unpersuasive. It follows that Appellants have not shown that the Examiner erred in finding that Thurrott anticipates independent claim 1.

Appellants did not provide separate arguments with respect to the rejection of claims 1, 10, 17, 22, 26 through 29, 31, and 32. We thus select claim 1 as being representative of the cited claims. It follows for the same reasons detailed in our discussion of claim 1 above that Appellants have not shown that the Examiner erred in rejecting claims 10, 17, 22, 26 through 29, 31, and 32. 37 C.F.R. § 41.37(c)(1)(vii).

2. *Cromer-1, 7-10, 12, 17, 22, 26- 29, 31, and 32*

As set forth above, Cromer discloses that upon failing to receive a response from a polled client computer connected to a network, a server computer alerts the network administrator through a message that the client computer might be disconnected or removed from the network. (FF. 2.) We note that both Appellants and the Examiner initially agreed that Cromer does teach that an alarm is generated to alert a network administrator that a client computer has been removed from the network, even though the alert is not generated in the removed client computer. (Ans. 4, App. Br. 5.) We find such initial characterization to accurately describe Cromer's disclosure. Particularly, we find that the message sent to the administrator comports with the definition of alarm that we adopted above. The message is at least a visual signal that informs the administrator of a potential problem having occurred on the network. We also agree with the Examiner that if the client computer is indeed disconnected from the network, it is therefore removed therefrom since it is no longer connected to the network. Thus, we do not agree with Appellants' argument that a removed client computer from the network would require independent AC powering. We find such argument to exceed the scope of the claimed invention since the claim does not recite independent powering of the removed device.

Further, we agree with the Examiner that the failure of the client computer to respond to a status inquiry from the server results in the alarm being generated. However, we do not agree that such a failure to respond to

the status inquiry teaches or suggests that the alarm is generated on the client computer, as alleged by the Examiner (Ans. 13-14.) It is clear from Cromer's disclosure that the message is generated on the server, and not the client computer. Therefore, the Examiner's finding is far too reaching. Nevertheless, we find that one of ordinary skill in the art would have found it obvious to modify Cromer to cause the alarm to be generated from the client computer at the time of the impending removal since such practice would predictably result in deterring or thwarting such unauthorized attempt. Thus, we find that Cromer renders claim 1 unpatentable.

Alternatively, we find that Cromer also anticipates claim 1. As noted above, Cromer teaches that the server device, upon detecting of its disconnection from a client computer, generates an alarm to alert the network administrator. (FF. 2.) We are satisfied that such teaching is sufficient to anticipate claim 1 since the alarm is generated in the server device, which is removed or disconnected from the client computer. Plainly put, the Cromer reference anticipates claim 1 because it teaches a server device that generates an alarm when the network connection between the server device with the client computer is broken.

Appellants' arguments at pages 5 through 8 of the Appeal Brief against the combination of Cromer with Thurrott, Sanders, Lam, Pearce, Sobell, and/or Minasi is misplaced since these secondary references were not relied upon to reject independent claims 1, 12, 17, 22, 31, and 32. Further, Appellants did not provide separate arguments regarding the rejection of

claims 7 through 10, and 26 through 29. We therefore select claim independent claim 1 as being representative of claims 7 through 10, 12, 17, 22, 26 through 29, 31, and 32. It follows, for the same reasons discussed above for claim 1, that Appellants have also failed to show error in the Examiner's rejection of these claims. 37 C.F.R. § 41.37(c)(1)(vii).

Claims 2, 3, 13, 14, 18, 19, 23, and 24

Appellants argue that the combination of Cromer, Sanders and Lam does not teach preventing the volume of an output device from being reduced below a predefined minimum level, as recited in claims 2 or from being turned off as recited in claim 3. (App. Br. 9.) We do not agree with Appellants. As detailed in the Findings of Fact section above, Sanders and Lam both teach sounding an audible alarm in a portable electronic device when a cable attached thereto has been pulled or removed. (FF. 3, 4.) We find that the suggested combination of Cromer, Sanders and Lam explicitly teaches sounding an alarm upon detecting that a cable connecting a portable computing device to a network has been pulled or severed. We also find that the suggested combination is silent on any mechanism to control the volume of the alarm or to turn off the computing device. Therefore, this absence of a volume control or a shut off mechanism in the proffered combination reasonably suggests that the volume of the alarm cannot be turned down or the removed device cannot be turned off. We note that the claimed

recitation is a negative limitation that does not particularly require the use of a special mechanism to turn down the volume of the alarm or to turn off the removed device. We are therefore satisfied that, without any evidence in the record before us to show otherwise, the absence of a control mechanism implies that the volume of the alarm cannot be turned down and that the removed device cannot be turned off. It follows that Appellants have not shown error in the Examiner's rejection of claims 2, 3, 13, 14, 18, 19, 23, and 24 as being unpatentable over the combination Cromer, Sanders and Lam.

Claims 3, 14, 19, and 24

Appellants argue that the combination of Cromer and Minasi does not teach preventing the volume of an output device from being turned off as recited in claim 3. (App. Br. 9.) We do not agree with Appellants. As detailed in the Findings of Fact section above, Minasi teaches assigning rights to a user to access certain objects on a network including the right to shut down a computing device. (FF. 5.) We find that the suggested combination of Cromer and Minasi teaches an administrator providing a user computer the right to turn off an NT server on a computing network. Further, we find no discussion in the proffered combination of controlling the volume of the alarm, or turning off the removed device. As discussed above, without any evidence in the record before us to show otherwise, the absence of a control mechanism implies that the volume of the alarm cannot

be turned down and that the removed device cannot be turned off. It follows that Appellants have shown error in the Examiner's rejection of claims 3, 14, 19, and 24 as being unpatentable over the combination Cromer and Minasi.

Appellants have not separately argued the rejection of claims 4 through 6, 11, 15, 16, 20, 21, 25, and 30. These arguments are therefore deemed to have been waived. *See* 37 CFR 41.37(c)(1) (vii). *See also In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004). It follows that Appellants have not shown that the Examiner erred in concluding that the cited claims are unpatentable over the proffered combinations.

VI. CONCLUSIONS OF LAW

1. Appellants have not shown that the Examiner erred in finding that Thurrott anticipates claims 1, 10, 17, 22, 26 through 29, 31, and 32.

2. Appellants have not shown that the Examiner erred in finding that Cromer anticipates claims 1, 7 through 10, 12, 17, 22, 26 through 29, 31, and 32.

3. Appellants have not shown that the Examiner erred in concluding that the combination of Cromer, Sanders, and Lam renders claims 2, 3, 13, 14, 18, 19, 23, and 24 unpatentable.

4. Appellants have not shown that the Examiner erred in concluding that the combination of Cromer and Minasi renders claims 3, 14, 19, and 24 unpatentable.

5. Appellants have not shown that the Examiner erred in concluding that the combination of Cromer and Pearce renders claims 4 and 5 unpatentable.

6. Appellants have not shown that the Examiner erred in concluding that the combination of Cromer and Scholl renders claims 6, 11, 15, 16, 20, 21, 25, and 30 unpatentable.

VII. DECISION

We affirm the Examiner's decision to reject claims 1 through 32.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

msc

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